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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,329

12/31/2003

Edgar Matias

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06/29/2006

PERRY & PARTNERS

1300 YONGE STREET

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TORONTO, ON M4T-1X3

CANADA

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,329

Applicant(s)

MATIAS ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 7 February 2006. Claims 1-11 are pending in the application.
2. The amendments to claims 8-11 are not fully compliant with the requirements of 37 CFR 1.121. Specifically, the applicant appears to use single brackets to delimit deleted text. The proper presentation of deleted text is with either strikethrough text (i.e. ~~deleted text~~) or double brackets (i.e. [[deleted text]]). For future reference, the strikethrough is preferable while the double bracket is used primarily when the strikethrough is difficult to ascertain, such as when deleting the number 4. To examine the claims on their merits, it is presumed that the text presented in brackets is deleted text.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action:

Claim Rejections - 35 USC § 112

4. In light of the above interpretation of the claim amendments, the rejection of claims 8-11 rejected under 35 U.S.C. 112, 2nd paragraph, are hereby withdrawn.

Claim Rejections - 35 USC § 102

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cyr (US 5,769,221).

Claims 1 and 2: In figures 3 and 4 of Cyr there is disclosed a shock absorbing spacer **56** comprising an impact absorbing body **59** having a thickness and an adhesive material **71** on both sides of the body. Insofar as the term "stackable" only requires the ability to stack, Cyr folds into a substantially flat article (see Figure 4) that is inherently "stackable" along its flat major surfaces **57**. Cyr is fully capable of being used in a carrying case in the manner claimed by the applicant.

Claim 3: Cyr discloses adhesive **71** as either a hook or loop of a hook-and-loop fastening system (see Col. 7, lines 44-46).

Claim 4: Cyr discloses absorbing body **59** as foam (see Col. 7, lines 6-8).

Claim 5: Cyr discloses spacer **56** having a generally parallelepiped shape (see Figure 3).

6. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Park (US 6,073,770).

In Figure 3, Park discloses a carrying case capable of carrying contents of differing sizes and shapes and comprising a plurality of internal sidewalls (as shown) and cushions **70** inserted between the sidewalls and the contents. As shown in Figure 8, Park anticipates cushions **70** to comprise a plurality of stackable, shock-absorbing

spacers **88, 90 & 92**. Adjacent shock-absorbing spacers **88, 90 & 92** are coupled to one another by means of wrap **76**.

Claim Rejections - 35 USC § 103

7. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Cyr.

Claim 7: Park, as applied to claim 6 above, discloses the claimed invention except for the adhesive. One of ordinary skill in the art would have recognized that, as presented, the spacers in Figure 8 of Park would be free to move relative to one another.

Cyr, at Figure 13 discloses the use of an adhesive **174** to retain foam spacers in a position to prevent movement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the spacers of Park with the adhesive of Cyr in order to prevent relative movement between the spacers.

Claim 8: Cyr discloses the adhesive on both sides of the spacer.

Claim 9: Cyr discloses hook-and-loop fasteners (Col. 11, lines 57-61).

Claim 10: both Park (Col. 5, lines 28-47) and Cyr (Col. 7, lines 6-8) disclose foam material.

Claim 11: Park discloses spacers with flat sides and rounded ends instead of parallelepiped shapes.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the spacers with a

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parallelepiped shape because applicant has not disclosed that the parallelepiped shape provides an advantage, is used for a particular purpose, or solves a stated problem.

One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either a parallelepiped shape or rounded end shape because applicant so states in paragraph [019] of the instant application.

Therefore, it would have been an obvious matter of design choice to modify the shape of the spacers to obtain the invention as specified in claim 11. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Response to Arguments

8. Applicant's arguments filed 7 February 2006 have been fully considered but they are not persuasive.

9. In response to applicant's argument that Cyr does not disclose the spacers stacked inside a case, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant's amendment presents the stacking and case in "intended use" form; the spacer, alone, is

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the article claimed. Although Cyr discloses the spacer used in a differing manner than that of the applicant, this does not detract from its capability to be used in the claimed manner. Moreover, the spacers are fully capable of use in a completely different case than that disclosed by Cyr.

10. In response to the applicant's arguments against Park alone, it is asserted that the shock-absorbing spacers of Park are coupled to one another by means of wrap **76**.

11. In response to the applicant's argument that Park "teaches away" from the claimed invention, although Park has a reason for having a specific number of spacers of varying resiliency, this does not detract from the fact that a plurality of spacers are presented as claimed. Moreover, Park does not criticize, discredit, or otherwise discourage the solution claimed. Park gives no reason why the spacers should slide with respect to each other so it is not seen how Park can teach away from the claimed invention.

12. In response to applicant's argument that Cyr teaches stacking in a certain manner, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have

suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
25 June 2006


Mickey Yu
Supervisory Patent Examiner
Group 3700